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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,184	01/03/2006	Yoshitsugu Morita	71,051-003	7050

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EXAMINER

WESTERBERG, NISSA M

ART UNIT	PAPER NUMBER
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1618

MAIL DATE	DELIVERY MODE
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04/24/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/526,184	Applicant(s) MORITA ET AL.	
	Examiner Nissa M. Westerberg	Art Unit 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3 - 10, 12 is/are pending in the application.
- 4a) Of the above claim(s) 6 and 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3 - 5, 8 - 10, 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicants' arguments, filed March 26, 2009, have been fully considered but they are not deemed to be fully persuasive. The following rejections and/or objections constitute the complete set presently being applied to the instant application.

Response to Amendment

1. The declaration under 37 CFR 1.132 filed March 26, 2009 is insufficient to overcome the rejection of claims 1, 3 – 5, 8 – 10 and 12 based upon Dalle et al. (US 6,013,682) in view of Lochhead et al. (1993) or Sang et al. (US 6,143,310) in view of Dalle et al. (US 6,013,682) under 35 USC 103(a) as set forth in the last Office action because: the declaration is an opinion declaration by an interested party, the declaration is not commensurate in scope with the claims and the comparisons made therein do not represent a comparison with the closest cited prior art. These points are discussed in more detail below.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 3 – 5, 8 – 10 and 12 were rejected under 35 U.S.C. 103(a) as being unpatentable over Dalle et al. (US 6,013,682) in view of Lochhead et al. (1993). This rejection is MAINTAINED for the reasons of record set forth in the Office Action mailed November 26, 2008 and those set forth below.

6. Claims 1, 3 – 5, 8 – 10 and 12 were rejected under 35 U.S.C. 103(a) as being unpatentable over Sang et al. (US 6,143,310) in view of Dalle et al. (US 6,013,682). This rejection is MAINTAINED for the reasons of record set forth in the Office Action mailed November 26, 2008 and those set forth below.

Applicant has combined the arguments in regards to these two separate rejections and therefore they will be addressed together by the Examiner. As the arguments presented by Applicant's counsel in the response beginning on p 6 and paragraphs 13 – 21 of the Declaration filed March 26, 2009 by Yoshitsugu Morita contain the same information and comparisons, the arguments and declaration will be treated together.

Applicant traverses this rejection on the grounds that each of the references fails to include one of the components (A) or (B) as recited in claim 1 of the instant application. The '310 patent (Sang et al.) and Lochhead et al. are utilized by the Examiner for the same purpose, namely a correlation with compound (B) of the present claims. There is no reason that one of skill in the art would expect the advantageous physical properties obtained from an aqueous emulsion including (A) a linear organosilicon polymer whose main chain is composed of diorganosiloxane units and alkylene units and (B) an oil that is liquid at room temperature and does not contain hydrosilation-reactive groups in a ratio of Component (A) to Component (B) of from 1:0.5 to 1:50. Examples 1 – 3 of Dalle et al. correspond to Comparative Example 1 of the present invention, which produces a mixture that was not homogenous and its

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viscosity could not be measured using a rotary viscometer. The corresponding Practical Example 4 of the instant invention, in contrast, formed an homogenous emulsion with excellent dispersability in water. Comparative Example 4 is an emulsion that contains only component (B) and was not homogenous and had undesirable dispersability in water. There is no reason that one of ordinary skill in the art would combine the emulsion of comparative example 1 with the emulsion of comparative example 4 as the physical properties of both are undesirable. The composition with both components (A) and components (B) had excellent smoothness and no sensation of tackiness when applied to skin and had excellent adhesion, smoothness and moistness when applied to hair. Comparative example 1 had no smoothness when applied onto skin and half the adhesion to hair as those of Practical Examples 1 – 4 and undesirable smoothness and moistness when used as a hair treatment. Comparative Example 4 had undesirable smoothness and tackiness when applied to skin and half the adhesion to hair as those of Practical Examples 1 – 4. Because of the properties of the emulsions containing only one of components (A) and (B), one of skill in the art would have no reason to expect the physical properties of an emulsion containing both of these components.

These arguments are not found persuasive. Sang et al. and Lochhead et al. may teach the same dimethicone compound, but Sang et al. also different ratios of the different siloxane compounds and thus the two references contain slightly different teachings in regards to component (B) of the instant claims. The instant claims also do not require that the aqueous emulsion be a homogenous one. Although the claims are

interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Further explanation as to how examples 1 – 3 of Dalle et al. correspond to Comparative Examples 1 – 3 of the instant application is required as the Examiner does not believe that they are the same. Examples 1 – 3 of Dalle et al. results in the preparation of component (A) of the instant claims and no emulsions are actually formed in these examples. In the different examples, the amount of liquid organohydrogenpolysiloxane is varied (0.9, 1 or 1.15 parts) and is reacted with a constant amount of dimethylvinylsiloxyl terminated polydimethylsiloxane in the presence of a platinum catalyst (col 7, ln 49 – 67). When emulsions are prepared in Dalle et al. (col 8, ln 25 – 67), the platinum catalyst was added prior to preparation of an emulsion. Comparative examples 1 – 3 of the instant application recite the use of a completely different ratio of 98 parts of dimethylpolysiloxane blocked at both end with dimethylvinylsiloxyl groups to 2 parts of dimethylpolysiloxane blocked at both ends with dimethylhydrogensiloxyl groups. Prior to mixing with a platinum catalyst, two different mixtures of a secondary tetradecyl ether with a secondary dodecyl ether of ethylene oxide with different HLB values are added and an emulsion formed. It is unclear if the constituents used are the same as they are described by different properties. Thus, the comparisons made are not made to the closest cited prior art. Additionally, the ratio of the various components changes from Comparative Examples 1 to Practical Example 1 as the ratio of dimethylpolysiloxane components blocked with dimethylvinylsiloxyl groups and dimethylhydrogensiloxyl groups to the secondary tetradecyl ether with a secondary

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dodecyl ether of ethylene oxide with different HLB values in the comparative is lower than in the practical Example 1. Thus it is unclear if the different properties of the emulsion are the result of the addition of the dimethylpolysiloxane having both end of the molecular blocked by triethylsiloxy groups and/or the change in the proportion of the other ingredients in the composition.

In order for evidence of unexpected results to be persuasive, the evidence must be commensurate in scope with the claims. While the altered smoothness, tackiness or adhesion to hair has been demonstrated for some composition, the compositions prepared are not commensurate in scope with the range of possible polymers for components (A) and (B) and the full range for ratios of (A):(B) encompassed by the claims, or examples from a narrower range that depict trend that would allow the artisan of ordinary skill in the art to reasonably extend the probative value thereof (see MPEP 716.02(d) from further discussion of this point).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nissa M. Westerberg whose telephone number is (571)270-3532. The examiner can normally be reached on M - F, 8:00 a.m. - 4 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael G. Hartley/
Supervisory Patent Examiner, Art Unit 1618

NMW

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